The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. ACRES

Appeal 2006-2837
Application 09/558,933
Technology Center 3700

ON BRIEF

Decided: January 17, 2007

Before LEVY, HORNER, and FETTING, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal involves claims 1 through 21, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We AFFIRM.

BACKGROUND

The appellant's invention relates to an electronic gaming machine and more particularly to such a machine having display electronics capable of displaying loyalty bonus information simultaneously with the game display. (Spec 1). An understanding of the invention can be derived from a reading of exemplary claims 1 and 12, which are reproduced below.

> 1. A method for displaying player account information on a display of a gaming device connected by a network to a host computer comprising:
>
> creating a player account accessible by the host computer;
>
> generating in first display electronics game display information to create an original image;
>
> accessing at the gaming device the player account from the host computer;
>
> generating in second display electronics player account display information to create an overlay image;
>
> combining the original image with the overlay image to create a combined image; and
>
> displaying the combined image on the display of the gaming device.

> 12. An apparatus for displaying additional information on a gaming machine display comprising:
>
> a host computer including a database of player tracking information;
>
> a gaming machine coupled to said host computer over a network, said gaming machine including a gaming machine display and gaming electronics for generating and projecting a game image onto the gaming machine display; and

> communication means for bi-directional communication between the host computer and the gaming machine, said communication means including supplemental commands operative with said gaming electronics to combine said game image with a player tracking image generated from said player tracking information communicated from said host computer to said gaming machine.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fertitta, III et al.(Fertitta)	US 6,302,793 B1	Oct. 16, 2001
Found	WO 97/12315	Apr. 3, 1997
Heidel	EP 0 769 769 A1	Apr. 23, 1997

REJECTIONS

Claims 12 through 16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Heidel.

Claims 1, 2, and 4-6 stand rejected under 35 U.S.C. § 103(a) as obvious over Heidel and Found.

Claims 3 and 7-11 stand rejected under 35 U.S.C. § 103(a) as obvious over Heidel, Found and Fertitta.

Claims 17 through 21 stand rejected under 35 U.S.C. § 103(a) as obvious over Heidel and Fertitta.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed Dec. 5, 2005) for the reasoning in support of the

rejection, and to appellant's brief (filed Apr. 7, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 12 through 16 rejected under 35 U.S.C. § 102(b) as anticipated by Heidel.

We note that the appellant argues these claims as a group. Accordingly, we select claim 12 as representative of the group.

The appellant argues that Heidel fails to describe "communication means including supplemental commands operative with said gaming electronics to combine said game image with a player tracking image" (Claim 12), because Heidel fails to show a video overlay device, but simply teaches generating a display image in the first instance. The appellant goes on to argue that to retrofit an existing game machine with the display of Heidel would require a completely replacing the gam machine controller whereas the claimed invention requires only adding a supplemental controller board (Br. 9-10). The examiner responds that claim 12 does not claim a video overlay device, and that Heidel does describe the claimed combination of a game image and player tracking image. (Answer 10-11).

We must agree with the examiner that claim 12 does not contain a limitation reciting a video overlay device. We do note that the claim element performing this is expressed as a "communication means," potentially raising the issue of whether

the communication means is to be construed under 35 U.S.C. § 112, sixth paragraph. We find that the further limitation within this element of "including supplemental commands operative with said gaming electronics to combine said game image with a player tracking image generated from said player tracking information " recites sufficient structure of the communication means to remove any requirement for such a construction, particularly in view of the absence of any argument by the appellant that the claim should be construed under 35 U.S.C. § 112, sixth paragraph. However, even if we were to construe this element under the sixth paragraph of § 112, we note that the specification includes an embodiment consistent with the examiner's construction that no video overlay device is claimed.

> FIG. 3 illustrates a block diagram of a first implementation of the invention adapted to overcome the drawbacks of prior art player tracking display systems. Here, the player tracking display is removed. Player-specific information is then routed directly to the game video display by expanding the information exchanged between the MCI 50 and game electronics 49. No additional serial port is required. Only additional commands must be defined ...
>
> (Spec. 8).

We further note that the appellant's Fig. 3 excludes any reference to a video overlay device, and that Heidel does describe combining the game image with player tracking information, at least at col. 6 lines 32 to 44, in which a service request area is combined with the game play area. Therefore, irrespective of whether construction is under 35 U.S.C. § 112, sixth paragraph, the claim does not require a video overlay device.

We finally note that the appellant also argues that "Heidel does not create separate original and overlay images but rather creates a combined image in the

first instance - there is thus no combination of images and thus no need for supplemental commands to perform such functions." (Br. 10). This argument also attempts to add limitations into the claim that are not there, as to the arguments, *supra*, that Heidel would require replacing the controller whereas the claimed invention requires only a supplemental board to retrofit existing machines. Claim 12 only requires combining images; whether those images have any preprocessing via some additional software to enable more efficient combination in one fell swoop is simply not an issue. Heidel is silent as to any such pre-processing, but clearly describes combining such images at the portions cited, *supra*.

Therefore, we find the appellant's arguments to be unpersuasive. Accordingly we sustain the examiner's rejection of claims 12 through 16 under 35 U.S.C. § 102(b) as anticipated by Heidel.

Claims 1, 2, and 4-6 rejected under 35 U.S.C. § 103(a) as obvious over Heidel and Found.

We note that the appellant argues these claims as a group. Accordingly, we select claim 1 as representative of the group.

The examiner applies Heidel to show overlay of images in a gaming apparatus, in which one of the images relates to a customer account, and applies Found to show the use of a video overlay device for implementing image overlay in a gaming environment. (Answer 4-6).

The appellant presents the same argument as against claim 12, *supra*., that no video overlay device is present in Heidel. Again, the examiner has relied on Found for the teaching of a video overlay device (Found 2, 6-7). Further, claim 1 recites no limitation to a video overlay device. Instead it recites a first and second display

electronics, which may be no more than a first and second memory storage area, which Heidel must inherently have to perform the combining of images recited in its col. 6.

The appellant further argues there is no motivation to combine Found's video overlay device with Heidel's overlay. (Br. 8-9). Found suggests the use of video overlay boards as mechanisms to allow multiple gaming devices, such as those in Heidel, to participate with one another (Found 1).

Therefore, we find the appellant's arguments to be unpersuasive. Accordingly we sustain the examiner's rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 103(a) as obvious over Heidel and Found.

Claims 3 and 7-11 rejected under 35 U.S.C. § 103(a) as obvious over Heidel, Found and Fertitta.

The appellant relies on the arguments for the patentability of claim 1, *supra.*, to support the patentability of these claims, and we find this argument unpersuasive for the same reason as we noted regarding claim 1. Accordingly we sustain the examiner's rejection of claims 3 and 7-11 under 35 U.S.C. § 103(a) as obvious over Heidel, Found and Fertitta.

Claims 17 through 21 rejected under 35 U.S.C. § 103(a) as obvious over Heidel and Fertitta.

Although the appellant does not recite these claim numbers in the arguments section pertaining to these claims (Br. 11), the reference by the appellant to the

Heidel/Fertitta combination, which the examiner has applied against these claims, clarifies that this portion of the argument is indeed meant to be applied toward these claims.

The appellant argues the absence of a video overlay device in Heidel and Fertitta (Br. 10). The examiner argues that Heidel's video controller (Fig. 2, ref. 56) is a video overlay device (Answer 3). We note that this claim element is not expressed in means plus function format.

The appellant refines this argument by stating that "Heidel does not create separate original and overlay images but rather creates a combined image in the first instance - there is thus no overlay." (Br. 11). This argument attempts to add limitations into the claim that are not there. Claim 13, from which claims 17 through 21 depend, only requires overlaying data on top of an image; such an image is, we note, just data stored in a video buffer, and combining data in a single buffer is overlaying a second set of data on a first set. Heidel is silent as to the specific processing, but a person of ordinary skill in the art would have immediately envisaged one implementation to be overlaying customer data on image data in performing the image combining operation of col. 6 lines 32-44, because the operation is implied to be reversible, which could not be done readily if the data were not retained and overlayed.

Accordingly we sustain the examiner's rejection of claims 17 through 21 under 35 U.S.C. § 103(a) as obvious over Heidel and Fertitta.

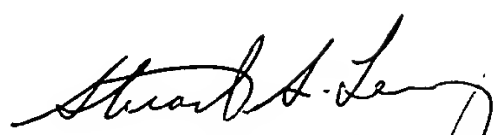
CONCLUSION

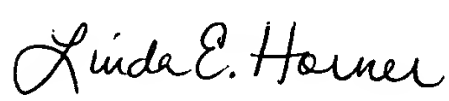
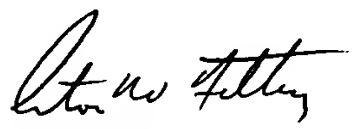
To summarize,

- The rejection of claims 12 through 16 under 35 U.S.C. § 102(b) as anticipated by Heidel is sustained.
- The rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 103(a) as obvious over Heidel and Found is sustained.
- The rejection of claims 3 and 7-11 under 35 U.S.C. § 103(a) as obvious over Heidel, Found and Fertitta is sustained.
- The rejection of claims 17 through 21 under 35 U.S.C. § 103(a) as obvious over Heidel and Fertitta is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



STUART S. LEVY)
Administrative Patent Judge)
)
)
)

) BOARD OF PATENT
LINDA E. HORNER) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)

)
ANTON W. FETTING)
Administrative Patent Judge)

Appeal Number: 2006-2837
Application Number: 09/558,933

Beyer, Weaver & Thomas, LLP
P.O. Box 70250
Oakland, CA 94612-0250

AWF/ki